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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,073	02/21/2002	Yoichi Iimura	0425-0877P	9107
2292	7590	02/19/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	
DATE MAILED: 02/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/069,073	Applicant(s) IIMURA ET AL.	
	Examiner Brenda L. Coleman	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Claims 1-20 are pending in the application.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 1-indanone.

Group II, claim(s) 1 and 4-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 1-benzazepine.

Group III, claim(s) 1 and 4-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 6H-pyrrolo[4,5-f]-1,2-benzisooxazol-6-one.

Group IV, claim(s) 1 and 4-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 2-methyl-6-benzothiazole.

Group V, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 1,3-oxo-indan.

Group VI, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 1-oxo-1,2,3,4-tetrahydronaphthalene.

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Group VII, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 6,7,8,9-tetrahydro-benzocyclohepten-5-one.

Group VIII, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is indole or indoline.

Group IX, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 1,2,3,4-tetrahydroquinoline.

Group X, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is benzoazepine.

Group XI, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is benzoazocine.

Group XII, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 1-oxo-1,2,3,4-tetrahydroacridine.

Group XIII, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 6, 7-dihydro-5H-cyclopentapyrimidine.

Group XIV, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is decahydro-acenaphthylen-1-one.

Group XV, claim(s) 1, 4-9 and 11-20, drawn to the compounds, compositions and method of use of the compounds of formula (I) where R<sup>1</sup> is 2,3-dihydro-1H-indole-2-carbaldehyde.

The inventions listed as Groups I-XV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I-XV are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of R<sup>1</sup> in formula (I) do not belong to a recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others, for example a compound where R<sup>1</sup> is 1-indanone is different from a 1-benzazepine, 6H-pyrrolo[4,5-f]-1,2-benzisoxazol-6-one, 2-methyl-6-benzothiazole, etc. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structures as functional equivalents of each other. The mere fact that there is a single similarity is not in itself a significant reason to render the whole embodiment obvious.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the

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prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Tentative election of a single species within the elected group is further required.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting -SPE of 1624 at 571-272-0661.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Brenda Coleman".

Brenda Coleman  
Primary Examiner Art Unit 1624  
February 16, 2004